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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,351	03/27/2001	Eiji Okano	FUJZ 18.491	1199
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KATTEN MUCHIN ROSENMAN LLP			SALCE, JASON P	
575 MADISON AVENUE			ART UNIT	
NEW YORK, NY 10022-2585			PAPER NUMBER	

2614

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,351

Applicant(s)

OKANO ET AL.

Examiner

Jason P. Salce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 9-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 7 is/are allowed.
- 6) ☒ Claim(s) 1-6 and 9-11 is/are rejected.
- 7) ☐ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/25/2006 has been entered.

Response to Arguments

2. Applicant's arguments filed 1/25/2006 have been fully considered but they are not persuasive.

Applicant argues that the terminal may detect the IP address that was in the DHCP message but the reference detects if from the ACK message which is sent to the CM. Applicant's claim states, "receiving DHCP messages to and from the subscriber terminal" and "relaying the DHCP messages as a relay agent". As disclosed in the specification and the claims, there is no single DHCP message in the DHCP process, there are a plurality of DHCP messages that are transmitted to and from a subscriber terminal, which provides the means for dynamically assigning an IP address to a subscriber terminal, which is what the DHCP was specifically implemented for. This is clearly disclosed in Figure 17 of Fijolek. The examiner agrees with Applicant that the IP address is detected from the ACK message and the examiner further notes that the

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ACK message is a DHCP message, that is one of a plurality of DHCP messages that are transmitted to and from the subscriber terminal in order to dynamically assign the subscriber terminal an IP address, which is clearly defined in applicant's own claim limitations. Also note Column 27, Lines 22-34, which describes how the CMTS sends the DHCPACK message to the CM so the CM can update the CM memory/table with the address routing information, therefore the DHCPACK message (which is one of the DHCP messages) clearly teaches detecting the IP address from the DHCP message.

Therefore, the prior art rejection stands and also reads on new claim 11 (see rejection below).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fijolek et al. (U.S. Patent No. 6,240,464) in view of Wong et al. (U.S. Patent No. 6,073,178).

Referring to claim 1, Fijolek discloses a cable modem system (see Figure 8) comprising a cable modem termination system (see CMTS 12 in Figure 8) for connecting a CATV center (see Headend 26 in Figure 8) to a CATV transmission line (see Cable Network 14 in Figure 8).

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Fijolek also discloses a cable modem (see Cable Modem 16 in Figure 8) for connecting a subscriber terminal (see CPE 20 in Figure 8) to the CATV transmission line (see Cable Network 14 in Figure 8). The examiner notes that if applicant wishes to express a plurality of subscriber terminals exist (as described in the claim objection to claim 1, discussed above), see Column 29, Lines 1-18 for connecting multiple network devices.

Fijolek also discloses a DHCP server (see DHCP server 160 in Figure 8 and Column 25, Lines 50-52) for dynamically allocating an IP address to the subscriber terminal by transmitting and receiving DHCP messages to and from the subscriber terminal through the cable modem (see Figures 15A-15B and Column 25, Lines 22-36 and Lines 58-67 and Column 26, Lines 1-4 and Lines 18-20 for the subscriber terminal transmitting a DCHPDISCOVER message to the DHCP server and for the subscriber terminal receiving a DCHPOFFER message from the DHCP server, in order to allocate an IP address to the subscriber terminal (see Column 26, Lines 28-30)).

Fijolek also discloses that the cable modem termination system has a DHCP server address-notifying portion for notifying the cable modem of a DHCP server address (see Column 9, Lines 63-67 and Column 10, Lines 1-22 and Lines 63-67 for when initial power-up of a cable modem, information is sent in the form of a TCD message, which contains SPD parameters, which contains the server address of a DHCP server).

Fijolek also discloses that the cable modem has a DHCP relay agent for relaying the DHCP messages as a relay agent (see Column 22, Lines 65-67 for the CM 16

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functioning as a standard relay agent), an IP address detector for detecting the IP address from the DHCP message (see Column 22, Lines 42-45 for detecting the IP address in the DHCPACK message and using this address for receiving data over the network), an IP address storage for storing the IP address (see Column 23, Lines 2-5 and Column 27, Lines 55-65 for storing IP address in a routing table), and a packet filtering portion for restricting the cable modem and subscriber terminals to use the IP addresses that they are assigned to (see Column 8, Lines 59-61 for the CM 16 and CPE 18 using IP 54 datagram filtering to restrict the CM 16 and CPE 18 to the use of only their assigned IP 54 addresses).

However, although Fijolek discloses a packet-filtering portion and that the cable modem 16 acts as a router for routing packets upstream from a subscriber terminal (see Column 28, Lines 4-7), Fijolek fails to disclose the details of the packet filtering functionality, such as discarding a packet when the source IP address is other than the IP address stored in the IP address storage when the packet is received from the subscriber.

Wong specifically details the specifics of packet filtering by a router in Figure 1. Wong also discloses that when the packet filtering portion is used, a packet is discarded when a source IP address other than the IP address stored in the IP address storage when the packet is received from the subscriber terminal (see Column 9, Lines 1-20 for comparing a source IP address to an assigned IP address stored in an IP address table (see Column 7, Lines 47-53) and if the source IP address is not found in the IP address table, then the packet (sent upstream from the subscriber terminal is discarded).

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At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify packet filtering process, as taught by Fijolek, using the upstream packet filtering process, as taught by Wong, for the purpose of preventing client systems from usurping IP addresses to gain illicit access to IP packets (see Column 3, Lines 14-16 of Wong).

Claim 3 corresponds to claim 1, where Fijolek discloses that the cable modem has a lease time storage for storing a lease time (see Column 30, Lines 19-21 for checking if the lease time is stored in an ARP table of the CMTS 12 and also note Column 30, Lines 50-55 for the ARP table being implemented in the cable modem 16 instead of the CMTS 12) of the IP address dynamically allocated to the subscriber terminal by the DHCP message (see Column 30, Lines 11-14 for assigning the IP address dynamically allocated to the subscriber terminal (CPE 18) by the DHCP message (DHCPACK message) sent from the DHCP server 66), and clears the IP address stored in the IP address storage after the lease time has expired (see Column 30, Lines 42-48 for clearing the IP address in the IP address storage (routing table) when the lease time has expired) to make the subscriber terminal be in a state where the IP address is unallocated (note that if the IP address is no longer in the IP address storage (routing table) then packets cannot be routed to that address, because the address is no longer allocated to a device in the IP address storage (routing table) at Column 30, Lines 42-48).

Claim 9 corresponds to claim 1, where Fijolek discloses that the cable modem connects a subscriber terminal to the CATV transmission line (see CM 16 connected to cable (CATV transmission line) network 14 in Figure 1).

Referring to claim 10, see the rejection of claim 1. Fijolek further teaches an allocated address manager for storing the IP address notified by the first cable modem in correspondence with an address of the cable modem itself (see Column 21, Lines 45-61), and notifying a second cable modem to clear the IP address (see Column 28, Lines 32-35), which the first cable modem previously detected (see Column 18, Lines 32-37 and note that previously detected is broad and reads on the CMTS sending offer messages to the cable modems, which enable the cable modems to detect all available IP addresses that are available for allocation), thereby making a subscriber terminal connected to the first cable modem be in a state of having an unallocated IP address (the examiner notes that if a cable modem is released from it's IP address, it is inherently is an unallocated device on the network).

Claim 11 corresponds to claim 1, where Fijolek discloses that said IP address detector detects the IP address from the DHCP message sent to the subscriber terminal when the DHCP message is transmitted to the subscriber terminal (see Figure 17 for receiving the DHCPACK message from the CMTS and the arguments above in the "Response to Arguments" section).

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4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fijolek et al. (U.S. Patent No. 6,240,464) in view of Wong et al. (U.S. Patent No. 6,073,178) in further view of Takahara et al. (U.S. Patent No. 6,078,583).

Claim 5 corresponds to claim 1, where Fijolek and Wong disclose all of the limitations in claim 1, and where Fijolek further teaches that the cable modem acts as a relay agent to forward traffic upstream from a subscriber terminal (see Column 22, Lines 65-67 and Column 28, Lines 4-7 for communicating with a DHCP server through the CM acting as a BOOTP relay agent) and that the subscriber terminal can send a release message (DHCP release message) to a host server in order to release the allocated IP address (see Column 28, 32-35 and Column 30, Lines 3-5). Therefore, since the CM 16 must forward DHCP messages sent from the subscriber terminal (CPE 18) to the CMTS 12 and DHCP server 160, the CM 16 must inherently have a release message detector, in order to send the message upstream to the CMTS 12 and DHCP server 160.

Fijolek also discloses that the CM 16 contains a routing table for forwarding data to the CPE 18 using it's proper IP address and MAC address combination (see Column 23, Lines 2-5 and Column 27, Lines 55-57 for routing data according to the proper IP/MAC address combination to the CPE), but fails to disclose clearing the IP address stored in the IP address storage when the DHCP release message is detected (from the subscriber terminal) to make the subscriber terminal be in a state where the IP address is unallocated.

Takahara discloses sending a release message from a subscriber terminal to a router, which contains a routing table (similar to the CM's routing table of Fijolek), where the message causes the routing table to delete the IP requested for release, sent from the subscriber terminal (see steps 414 and 415 of Figure 5 and Column 5, Lines 55-60 and Column 6, Lines 27-31). Also note that if the IP address is no longer in the IP address storage (routing table) then packets cannot be routed to that address, because the address is no longer allocated to a device in the IP address storage (routing table), therefore the subscriber terminal is in a state where the IP address is unallocated.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the DHCPRelease message sent from the CPE 18, as taught by Fijolek and Wong, using the release message that clears the IP address from IP address storage, as taught by Takahara, for the purpose of making it easier to start communications between terminals connected to the internet through the public network (see Column 1, Lines 50-52 of Takahara).

5. Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fijolek et al. (U.S. Patent No. 6,240,464) in view of Wong et al. (U.S. Patent No. 6,073,178) in further view of Philippou et al. (U.S. Patent No. 6,385,648).

Referring to claim 2, Fijolek and Wong disclose all of the limitations in claim 1, as well as a packet filtering portion that discards a packet having a source IP address other than the assigned IP address when the packet is received from the subscriber terminal (see the rejection of claim 1).

However, although Fijolek and Wong disclose that a subscriber terminal is in a state where an IP address is unallocated by the DHCP server (see Column 28, Lines 32-35 of Fijolek for the unallocating of a subscriber terminal), Fijolek and Wong fail to disclose that if the subscriber terminal is in an unallocated state that the subscriber terminal has a predetermined initial IP address.

Philippou discloses that an uninitialized box (see Figure 3) can have an IP address set to a predetermined arbitrary IP address, such as 0.0.0.0, when there has been no IP address allocated to the box (see Column 6, Lines 41-47).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the subscriber terminal (CPE 18), as taught by Fijolek and Wong, using the predetermined initial IP address stored in the uninitialized box (subscriber terminal/CPE 18), as taught by Philippou, for the purpose of preventing a network administrator from manually having to set the network identifier before the box is recognized in the network and allowing an uninitialized box with a default address (see arguments above in regards to a predetermined initial IP address) to be automatically allocated an identifier upon connection to the network (see Column 1, Lines 54-66 of Philippou).

Claim 4 corresponds to claim 2, where Fijolek discloses that the cable modem has a lease time storage for storing a lease time (see Column 30, Lines 19-21 for checking if the lease time is stored in an ARP table of the CMTS 12 and also note Column 30, Lines 50-55 for the ARP table being implemented in the cable modem 16 instead of the CMTS 12) of the IP address dynamically allocated to the subscriber

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terminal by the DHCP message (see Column 30, Lines 11-14 for assigning the IP address dynamically allocated to the subscriber terminal (CPE 18) by the DHCP message (DHCPACK message) sent from the DHCP server 66), and clears the IP address stored in the IP address storage after the lease time has expired (see Column 30, Lines 42-48 for clearing the IP address in the IP address storage (routing table) when the lease time has expired) to make the subscriber terminal be in a state where the IP address is unallocated (note that if the IP address is no longer in the IP address storage (routing table) then packets cannot be routed to that address, because the address is no longer allocated to a device in the IP address storage (routing table) at Column 30, Lines 42-48).

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fijolek et al. (U.S. Patent No. 6,240,464) in view of Wong et al. (U.S. Patent No. 6,073,178) in further view of Philippou et al. (U.S. Patent No. 6,385,648) in further view of Takahara et al. (U.S. Patent No. 6,078,583).

Claim 6 corresponds to claim 2, where Fijolek, Wong and Philippou, disclose all of the limitations in claim 2, as well as Fijolek disclosing that the cable modem acts as a relay agent to forward traffic upstream from a subscriber terminal (see Column 22, Lines 65-67 and Column 28, Lines 4-7 for communicating with a DHCP server through the CM acting as a BOOTP relay agent) and that the subscriber terminal can send a release message (DHCP release message) to a host server in order to release the allocated IP address (see Column 28, 32-35 and Column 30, Lines 3-5). Therefore, since the CM

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16 must forward DHCP messages sent from the subscriber terminal (CPE 18) to the CMTS 12 and DHCP server 160, the CM 16 must inherently have a release message detector, in order to send the message upstream to the CMTS 12 and DHCP server 160.

Fijolek also discloses that the CM 16 contains a routing table for forwarding data to the CPE 18 using its proper IP address and MAC address combination (see Column 23, Lines 2-5 and Column 27, Lines 55-57 for routing data according to the proper IP/MAC address combination to the CPE), but fails to disclose clearing the IP address stored in the IP address storage when the DHCP release message is detected (from the subscriber terminal) to make the subscriber terminal be in a state where the IP address is unallocated.

Takahara discloses sending a release message from a subscriber terminal to a router, which contains a routing table (similar to the CM's routing table of Fijolek), where the message causes the routing table to delete the IP requested for release, sent from the subscriber terminal (see steps 414 and 415 of Figure 5 and Column 5, Lines 55-60 and Column 6, Lines 27-31). Also note that if the IP address is no longer in the IP address storage (routing table) then packets cannot be routed to that address, because the address is no longer allocated to a device in the IP address storage (routing table), therefore the subscriber terminal is in a state where the IP address is unallocated.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the DHCPRelease message sent from the CPE 18, as taught by Fijolek, Wong and Philippou, using the release message that clears the IP

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address from IP address storage, as taught by Takahara, for the purpose of making it easier to start communications between terminals connected to the internet through the public network (see Column 1, Lines 50-52 of Takahara).

Allowable Subject Matter

7. Claim 7 is allowed.

8. Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance:

Referring to claims 7-8, the prior art of record fails to anticipate or rendered obvious notifying the other (second) cable modem to clear the stored IP address to make the subscriber terminal connected to the other (second cable) modem be in a state where the IP address is unallocated when the address is already stored by a notification from another (first) cable modem. Claim 7 is represented in the specification by Figure 15, for sending a prohibited IP notification (M34) to a cable modem 200, after a cable modem 300 receives an IP address that was previously stored in cable modem 200, and was not properly deleted after the expiration time. Fijolek teaches the notification of deleting (releasing) an IP address from its table, but fails to teach doing

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so after another cable modem has already stored the IP address, which prevents improper dual use of the same IP address.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jason P Salce
Patent Examiner

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March 7, 2006

Jason Sube